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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/658,799

09/10/2003

Seong-Jin Moon

1101.0109

1813

89980

7590

08/03/2010

North Star Intellectual Property Law, PC

P.O. Box 34688

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EXAMINER

TOPGYAL, GELEK W

ART UNIT

PAPER NUMBER

2621

MAIL DATE

DELIVERY MODE

08/03/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/658,799	Applicant(s) MOON ET AL.	
	Examiner GELEK TOPGYAL	Art Unit 2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 May 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,5 and 42-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5 and 42-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to the prior art rejections of claims 1-2, 4-5 and 42-25 have been considered but are moot in view of the new ground(s) of rejection.
2. Applicant's arguments, see pages 5-6, filed 5/19/2010, with respect to the Double Patenting rejections on copending US applications 12/170,942, 12/170,964, 12/170,975, 12/170,992 and 12/170,911 have been fully considered and are persuasive. The nonstatutory obviousness-type double patenting rejections over copending US applications 12/170,942, 12/170,964, 12/170,975, 12/170,992 and 12/170,911 have been withdrawn.
3. Applicant's arguments, see page 4, filed 5/19/2010, regarding the rejections under 35 USC 101 have been considered. In response, the examiner clarifies the rejection below.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The USPTO "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" (Official Gazette notice of 22 November 2005), Annex IV, reads as follows:

Claims that recite nothing but the physical characteristics of a form or energy, such as a frequency, voltage, or the strength of a magnetic field, define energy or magnetism, per se, and as such are nonstatutory natural phenomena. O'Reilly, 56 U.S. (15 How.) at 112-14. Moreover, it does not appear that a claim reciting a signal encoded with functional descriptive material falls within any of the categories of patentable subject matter set forth in Sec. 101.

... a signal does not fall within one of four statutory classes of 101.

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... signal claims are ineligible for patent protection because they do not fall within any of the four statutory classes of Sec. 10

5. **Claims 1-2 and 4-5** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows. Regarding claims 1-2 and 4-5, in the state of the art, transitory signals are commonplace as a medium for transmitting computer instruction and thus, in the absence of any evidence to the contrary and give the broadest reasonable interpretation, the scope of a "data storage medium" covers a signal per se. Therefore, it is suggested by the examiner that the applicants amend the claims to additionally recite that the data storage medium is of a "non-transitory" type.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. **Claims 1-2, 4-5 and 42-45** are rejected under 35 U.S.C. 102(e) as being anticipated by Kato et al. (US 2002/0164152).

8. **Regarding claim 1**, Kato et al. teaches a data storage medium for use with a recording and/or reproducing apparatus (paragraph 15), comprising:

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a first file comprising at least one clip, each clip comprising audio visual stream data (Paragraph 220 teaches an AV stream file) and a timemap comprising information on reproduction time when the audio visual stream data is reproduced (Paragraphs 194-196 and 337 and 340 teaches of PTS information (PTS_EP_start) stored within CPI (which is part of the CLIPINF file (see Fig. 14))) and information on a reproduction position of the audio visual stream data corresponding to the reproduction time Paragraphs 194-196 and 337 and 340 teaches of address information (RSPN_EP_start) stored within CPI (which is part of the CLIPINF file (see Fig. 14)));

a second file comprising at least one reproduction information unit for reproducing audio visual stream data, each reproduction information unit comprising information indicating a reproduction interval of a corresponding clip (Fig. 29-30 and respective disclosure teaches of either 1) Real Playlists or 2) Virtual Playlists that includes within their syntax plurality of IN and OUT points for indicating a reproduction interval. The Real Playlist or the Virtual Playlist is stored in a separate file in Fig. 14); and

a third file comprising navigation data including at least one command, each command controlling reproduction of a corresponding reproduction information unit (Paragraphs 368-376 teaches of mark information that is stored in either a Menu.thmb or Mark.thmb file. The mark information can be of a volume, playlist or clip type. Upon initial playback a thumbnail (representative picture) corresponding to a volume or a playlist can be displayed and operable for user selection (see paragraphs 156-158) These marks (stored in menu.thmb file (Fig. 75 and 78-79)) allows for the commands of

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playing a particular mark (be it volume, playlist, clip or for fast forward purposes as well)), wherein the first file, the second file and the third file are recorded separately on the data storage medium (as discussed above, also see Fig. 14 wherein the AV stream file, playlists and the menu or mark thumb files are recorded separately).

Regarding claim 42, Kato et al. teaches a reproducing apparatus for reproducing data from a data storage medium, comprising:

a reader which reads a first file, a second file and a third file from the data storage medium (Fig. 1, teaches of a Readout Unit 28 that reads the data stored on the recording medium 100, which includes the files as illustrated in Fig. 14), the first file comprising at least one clip (Paragraph 220 teaches an AV stream file), each clip comprising audio visual stream data (Paragraph 220 teaches an AV stream file) and a timemap comprising information on reproduction time when the audio visual stream data is reproduced (Paragraphs 194-196 and 337 and 340 teaches of PTS information (PTS_EP_start) stored within CPI (which is part of the CLIPINF file (see Fig. 14))) and information on a reproduction position of the audio visual stream data corresponding to the reproduction time (Paragraphs 194-196 and 337 and 340 teaches of address information (RSPN_EP_start) stored within CPI (which is part of the CLIPINF file (see Fig. 14))), the second file comprising at least one reproduction information unit for reproducing audio visual stream data, each reproduction information unit comprising information indicating a reproduction interval of a corresponding clip (Fig. 29-30 and respective disclosure teaches of either 1) Real Playlists or 2) Virtual Playlists that includes within their syntax plurality of IN and OUT points for indicating a reproduction

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interval. The Real Playlist or the Virtual Playlist is stored in a separate file in Fig. 14), and the third file comprising navigation data including at least one command, each command controlling reproduction of a corresponding reproduction information unit ((Paragraphs 368-376 teaches of mark information that is stored in either a Menu.thmb or Mark.thmb file. The mark information can be of a volume, playlist or clip type. Upon initial playback a thumbnail (representative picture) corresponding to a volume or a playlist can be displayed and operable for user selection (see paragraphs 156-158) These marks (stored in menu.thmb file (Figs. 75 and 78-79)) allows for the commands of playing a particular mark (be it volume, playlist, clip or for fast forward purposes as well)), wherein the first file, the second file and the third file are recorded separately on the data storage medium (as discussed above, also see Fig. 14)); and

a controller which reproduces the audio visual stream data from the data storage medium based on the first file, the second file and the third file (paragraphs 152-153 that teaches of reproducing the data stored on the medium. As discussed above with regards to the first, second and third file, the apparatus' controller 23 controls the reproduction based on the first, second and third file),

wherein the first file, the second file, and the third file are recorded separately on the data storage medium (as discussed above, also see Fig. 14 wherein the AV stream file, playlists and the menu or mark thumb files are recorded separately).

Regarding claims 2 and 43, Kato et al. teaches the claimed as discussed above in claims 1 and 42 and furthermore, the Clip AV stream includes audio and video data.

Regarding claims 4 and 44, Kato et al. teaches the claimed as discussed above in claims 1 and 42 and furthermore, the playlist file is recorded separately (within DVR folder, the .rpls or .vpls files are recorded separately within finite files), logically and physically from the menu or mark thumb files (second layer) in Figure 14. The first layer is met by the DVR folder.

Regarding claims 5 and 45, Kato et al. teaches the claimed as discussed above in claims 1 and 42 and illustrated in Fig. 14, the menu or mark thumb files are on top of the DVR folder (first layer).

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited prior art teaches of an apparatus that records and reproduces.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GELEK TOPGYAL whose telephone number is (571)272-8891. The examiner can normally be reached on 8:30am -5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thai Tran can be reached on 571-272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Gelek Topgyal/
Examiner, Art Unit 2621

/JAMIE JO ATALA/
Primary Examiner, Art Unit 2621